REMARKS

Claims 42-82 are pending in the present application with claims 42, 61, and 71 being the independent claims. Applicants herein amend claims 42, 61, 71, and 78.

Claims 42-82 are rejected under 35 U.S.C. § 112 as allegedly failing to comply with the written description requirement.

Claims 42-50, 52-53, 27, 61-66, 71-75, 78, and 82 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Russo (US Pat. 5,619,247) in view of Knight et al. (US Pat. 6,243,350) and further in view of Edenson et al. (US Pat. 6,198,875).

Claims 54-56, 59-60, 67-68, 70, 76, 79, 80, and 81 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Russo (US Pat. 5,619,247) in view of Knight et al. (US Pat. 6,243,350) and Edenson et al. (US Pat. 6,198,875), and further in view of Braitberg (WO 01/54410 A2).

Claim 51 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Russo (US Pat. 5,619,247) in view of Knight et al. (US Pat. 6,243,350) and Edenson et al. (US Pat. 6,198,875) as applied to claim 50 above, and further in view of Goode et al. (US Pre Grant Pub. 2004/0083492).

Claims 58 and 77 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Russo (US Pat. 5,619,247) in view of Knight et al. (US Pat. 6,243,350) and Edenson et al. (US Pat. 6,198,875) as applied to claims 57 and 71 above, and further in view of Voyticky (US Pat. 6,438,751).

Applicants respectfully request further examination and review in view of the amendments and remarks below.

CLAIM REJECTIONS – 35 U.S.C. §112

Claims 42-82 stand rejected under 35 U.S.C. § 112 as allegedly failing to comply with the written description requirement. In the outstanding Office Action, the Examiner states: "While this step of programming the controller chip to perform the above-mentioned method is obvious to one of ordinary skill, the step [*sic*] neither inherent nor explicitly disclosed in the specification." (Office Action of 2/7/07, p. 2.) Applicants note that the Examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art

would not recognize in an applicant's disclosure a description of the invention defined by the claims. (MPEP §2163.04, citing *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).) As the Examiner points out, the step of programming the controller chip to perform the method of Claim 42 is obvious to one of ordinary skill.

What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d at 1384, 231 USPQ at 94. (MPEP, § 2163 II.A.3.) If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., Vas-Cath, 935 F.2d at 1563, 19 USPQ2d at 1116; Martin v. Johnson, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (Id.) Thus, Applicants submit that one skilled in the art would recognize in the disclosure an adequate description of the invention defined by the claims.

While Applicants do not concede the propriety of the 35 U.S.C. § 112 rejection, in order to expedite examination of the application, Applicants hereby amend claims 42, 61, and 71 to further clarify Applicants' techniques. Support for the claim amendment is found in the specification at least at paragraphs 0019 and 0034. Applicants respectfully request that the rejection of Claims 42 – 82 under 35 U.S.C. § 112 be reconsidered and withdrawn.

CLAIM REJECTIONS – 35 U.S.C. §103(a)

The Examiner rejected all of the pending claims under 35 U.S.C. §103(a) over Russo in combination with one or more of Knight et al., Edenson et al., Braitberg, Goode et al., and Voyticky. Applicants respectfully traverse the rejections. Claim 42 as amended recites, in part:

> counting with the reader device how many times a video segment of the plurality of video segments is played, said counting enabled via a controller of the reader device, wherein said controller is configured to instruct a servo to move to tracks of said multilayer storage medium containing video segments to be viewed.

The Examiner concedes that "Russo … lacks the step of counting how many times a video segment of the plurality of video segments is played, the counting enabled via the reader device instructing servo to move to tracks of the storage medium containing the segments to be viewed," but goes on to state that "Knight further discloses using a focusing

servo system that instructs a servo to move to tracks of the multilayer storage medium for reading the tracks." (Office Action of 2/7/07, p. 4.) Knight describes the function of the focusing servo thus:

> "Alternatively, a non-near-field configuration can also be used with the flying head 230, in which case the separation between the flying head and the recording layer does not allow efficient coupling of evanescent waves and thus a conventional servo focusing system is needed to *directly focus the beam onto the recording surface*." (Knight, column 8, lines 34-39.)
>
> "In such a non-near-field configuration, a focusing servo system may be desirable *to maintain focusing of the read or write beam*." (Knight, column 11, lines 48-50.)
>
> "A focusing servo system is needed, however, *to maintain the optimal focusing*. Such a focusing servo system is well known in the art which implements, for example, a quadrant detector to sense changes of the beam shape of the reflected beam due to variations in focusing." (Knight, column 21, lines 23-27.)

Applicants submit that the focusing servo system described in Knight does not move to tracks of the multilayer storage medium for reading the tracks. Rather it is used to maintain the focus of a beam on the recording surface. Knight does describe "a tracking mechanism to direct the beam to the selected location of the medium and maintain the beam in the selected track." (Knight, column 21, lines 13-15.) However, Knight contains no description of counting how many times a video segment of a plurality of video segments is played, nor of any counting enabled via a controller configured to instruct a servo to move to tracks containing video segments to be viewed.

The Examiner states that "Edenson discloses the step of maintaining a time counter to count the number [of times] a media has been played or used to enable pay per view pricing or limit the number of authorized runs." (Office Action of 2/7/07, p. 5.) The cited passage in Edenson states:

> … the last 64 bits (as shown in FIG. 1) could be reserved to contain post-manufactured rewritable data such as the run/elapsed viewing; time counter to count the number of times *the media* has been played or used, i.e. to enable pay-per-view pricing, or limit the number of authorized runs for run-specific pricing. (Edenson, column 5, lines 59-63, emphasis added.)

Edenson consistently uses the term "media" to describe a data storage object, for example an optical disk such as a DVD, and not the content stored on the media:

> "The explosion of removable digital media in the marketplace today … In particular, *optical disk media* …"(Edenson, column 1, lines 60-63.)
> "… upon *insertion of the media* into a media player …" (column 2, lines 18-19.)
> "For example, if the media were Digital Video Disks, the only cost increase to the copyright holders would be the addition of a transponder *to the media itself*…" (column 2, lines 39-41.)
> "… *which form of media* has been inserted …" (column 4, lines 11-12.)
> "For example, if *the media element* is a digital video disk (DVD), …" (column 4, lines 66-67.)
> "… the algorithm used to decrypt the digital content of *the media*." (column 5, lines 2-3.)

Applicants submit that counting how many times a video segment of a plurality of video segments is played, the counting enabled via a controller that is configured to instruct a servo to move to tracks of an optical disk containing video segments to be viewed is patentably defined over maintaining a time counter to count the number of times a medium, such as an optical disk, has been played. Edenson does not disclose or suggest moving to tracks containing a video segment from among a plurality of video segments stored on a storage medium, nor does he disclose or suggest counting enabled via a controller configured to instruct a servo to move to such tracks. Applicants are unable to discern from the disclosure of Edenson how the time counter would be able to count "how many times *a video segment of the plurality of video segments* is played" such as recited in Claim 1. Merely knowing how long a media is played does not enable one to count how many times a video segment from among a plurality of video segments stored on the media is played.

For at least the reasons explained above, Applicants respectfully submit that the cited references, either alone or in combination, do not teach the quoted claim recitation and, therefore, Claim 42 is patentably defined over the cited art. Accordingly, Applicants respectfully request that the rejection of Claim 42 be reconsidered and withdrawn.

Independent Claims 61 and 71 contain recitations similar to the quoted recitation of Claim 42 above. Thus, for at least the reasons presented above with respect to Claim 42,

Applicants respectfully submit that Claims 61 and 71 are patentably defined over the cited art. Accordingly, Applicants respectfully request that the rejection of Claims 61 and 71 be reconsidered and withdrawn.

Claims 43 – 60 depend, directly or indirectly, from Claim 42. Claims 62 – 70 depend, directly or indirectly, from Claim 61. Claims 72 – 82 depend, directly or indirectly, from Claim 71. Applicants respectfully submit that for at least the reasons explained above with respect to independent Claims 42, 61, and 71, the pending dependent claims are patentably defined over the cited art and, accordingly, respectfully request that the rejection of these dependent claims be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner believes that a teleconference can facilitate prosecution of the present application, the Examiner is encouraged to contact applicant's attorney, Kenneth Plochinski, at (206) 903-2475.

Date: August 6, 2007

/Kenneth E. Plochinski/
Kenneth E. Plochinski
Registration No. 59,166

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439